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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,293	07/03/2003	John Sargent French	CIRC.002C	3984

7590 06/14/2005
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EXAMINER

NGUYEN, TU T

ART UNIT PAPER NUMBER

2877

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,293

Applicant(s)

FRENCH ET AL.

Examiner

Tu T. Nguyen

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/29/2004</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species I (claims 1-20) in the reply filed on 04/01/2005 is acknowledged.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16,18-19 of copending Application No. 10/613,299. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application no. 10/613,299 disclose all the limitations of the claimed application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (5,148,230) in view of Joline et al (6,005,696).

With respect to claims 1, Lane discloses a testing unit for test a DUT. The unit comprises: an optical transmitter 8 (fig 1), which transmits an optical test signal that is transmitted to a DUT 6 (fig 1); an optical receiver 20 (fig 1), which receives an input signal from the DUT; a display device 32 (fig 1) which provides an interface with a user; a memory module 28 (fig 1); a controller 30,34 (fig 1), selectively coupled to said

transmitter, said receiver and said display device, wherein said controller provides a central control of said transmitter, said receiver and said display device.

Lane does not explicitly disclose a graphical user interface (GUI hereinafter). Joline discloses a GUI (column 4, lines 18-30 and column 11, lines 55-65). It would have been obvious to modify Lane with the GUI as disclosed by Joline to let the user select different tests or different DUTs as taught by Joline in column 4, lines 18-30 and column 11, lines 55-65.

With respect to claims 3,4, Lane discloses using a memory for storing testing data utilized by the controller 30,34 (fig 1). However, Lane does not explicitly disclose a sensitivity module or a standard success criteria module. It would have been obvious to modify Lane with different modules for testing different characteristics of the DUT.

Claims 2,5,10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (5,148,230) in view of Joline et al (6,005,696) and Tanimoto et al (6,069,697).

With respect to claims 2,15, Lane does not disclose a calibration module. Tanimoto discloses a system comprising a calibrating process for calibrating the system (column 6). It would have been obvious to modify Lane with the calibrating process as taught by Tanimoto in column 6 to facilitate the measuring.

With respect to claims 5, Tanimoto discloses disposing the unit to a housing (column 5, line 58). It would have been obvious to modify Lane with the housing as taught by Tanimoto to reduce the system noise.

With respect to claim 10, refer to discussion in claim 1 above for the system and claim 5 above for the housing. The claimed measuring bit error rate would have been known in the art. It would have been obvious to modify Lane with the known BER method for measuring the BER of the DUT.

With respect to claims 11, 18, refer to discussion in claim 1 above for the transmitter and the GUI.

With respect to claim 12, it would have been obvious to modify Lane by locating the optical receiver 20 (fig 1) within the unit to facilitate the measuring.

With respect to claim 13, refer to discussion in claim 1 above for the memory module.

With respect to claims 14, 16, refer to discussion in claim 3 above for the testing or sensitivity module.

With respect to claim 17, refer to discussion in claim 3 above for the standard success module.

With respect to claim 19, since Joline discloses letting the user to select different tests or different DUTs (column 4, lines 18-30 and column 11, lines 55-65), the claimed manually inputs would have been inherent. It would have been obvious to modify Joline GUI to let the users terminate the measuring to reduce unwanted testing time.

With respect to claim 20, it would have been obvious to modify Lane to perform the BER measuring after an automated calibration procedure to facilitate the testing.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (5,148,230) in view of Joline et al (6,005,696) and Coin et al (6,590,644).

With respect to claim 6, Lane does not disclose an optical power monitor. Coin discloses a system comprising a power meter 80 (fig 4). It would have been obvious to modify Lane with the power meter as disclosed in Coin to monitor the power of the signal.

Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lane et al (5,148,230) in view of Joline et al (6,005,696), Coin et al (6,590,644) and Tanimoto et al (6,069,697).

With respect to claim 7, Lane does not disclose an optical attenuator. Tanimoto discloses a system comprising an optical attenuator 2 (fig 1). It would have been obvious to modify Lane with Tanimoto's optical attenuator to control the level of the light as taught by Tanimoto in column 5, lines 40-45.

With respect to claim 8, Tanimoto discloses a control unit 12 (fig 1) for controlling the optical attenuator 2 (fig 2). It would have been obvious to modify Lane's controller to control the attenuator as taught by Tanimoto to control the testing range.

With respect to claim 9, it would have been obvious to modify Lane's controlling unit by iteratively performs the adjustments for make the system more accurate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tu T. Nguyen whose telephone number is (571) 272-2424. The examiner can normally be reached on T-F 7:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Toatley Jr. can be reached on (571) 272-2800 Ext. 77. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Tu T. Nguyen', with a long, sweeping horizontal stroke extending to the right.

Tu T. Nguyen
Primary Examiner
Art Unit 2877

06/08/2005